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DATE: March 6, 2003

Please deliver the following Request to Withdraw Finality of Office Action As Premature under MPEP 706.07(c) to:

NAME: Examiner M. DiBrino - Group Art 1644
U.S. Patent and Trademark office
Washington, DC 20231

OFFICE ACTION
3/6/03
MD

Fax No.: (703) 746-5244

FROM: Wendy M. Lee
Registration No.: 40,378

RE: U.S. Serial No.: 09/705,457
Our Docket No.: P0998D3

Number of Pages including this cover sheet - 3

Certificate of Facsimile Transmission Under 37 CFR § 1.8

In accordance with CFR § 1.6(d), this correspondence addressed to The Patent and Trademark Office, Washington, DC 20231 is being transmitted to facsimile No. (703) 746-5244 *Anna Kan 3/6/2003*

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#16

Patent Docket P0998D3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of James Andya et al. Serial No.: 09/705,457 Filed: November 2, 2000 For: PROTEIN FORMULATION	Group Art Unit: 1644 Examiner: M. DiBrino Certificate of Receipt of Translation Under 37 CFR 1.6 In accordance with CFR 1.6(d), the correspondence addressed to the Patent and Trademark Office, Washington, DC 20231 is being transmitted to Applicant No. 17037465244 March 6, 2003 <i>Anna Kan</i> Anna Kan
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REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION
AS PREMATURE UNDER MPEP 706.07(c)

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

Applicants respectfully request withdrawal of the final Office Action mailed 1/13/03 (Paper #15) as premature. In that Office Action a new ground of rejection - namely a Section 103(a) rejection of claims 37-40, 44 and 45 based on US Patent No. 5,965,709 ("the '709 patent") and US Patent 4,093,606 ("the '606 patent") - is raised. The '709 patent was cited in the previous Office Action (Paper #13). The '606 patent was cited by Applicants in the IDS mailed 1/24/01, before the first Office Action was mailed.

MPEP 706.07(a) states that an Office Action shall not be final "where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

Neither the '709 patent, nor the '606 patent, were submitted in an IDS filed during the period set forth in 37 CFR 1.97(c). Moreover, Applicants submit that the Examiner hasn't shown how Applicant's 9/30/02 amendment of claim 37, deleting the word "about," necessitates the new rejection of that claim.

Accordingly, Applicants respectfully request that the finality of the Office

Serial No.: 09/705,457

Action be withdrawn. Applicants would appreciate it if the Examiner could call the undersigned concerning the PTO's response to this request.

Respectfully submitted,
GENENTECH, INC.

Date: March 6, 2003

By: W. M. Lee
Wendy M. Lee
Reg. No. 40,378
Telephone: (650) 225-1994



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PATENT TRADEMARK OFFICE